

REMARKS

Upon entry of the instant amendment, claims 17-30 will remain pending in the instant application and stand ready for further action on the merits.

In the instant amendment, claims 13-16 are cancelled and claim 17 is amended. The amendment to claim 17 basically changes the transitional phrase “contains” to the more limiting transitional phrase “*consisting essentially of*”. As such, the present amendment does not incorporate new matter into the application as originally filed, and entry thereof is thus respectfully requested at present.

Provisional Double Patenting Rejection

Claims 13, 22, 23 and 25-30 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36, 47, 48 and 63-65 of copending U.S. Application Serial No. 10/220,022. Reconsideration and withdraw of this provisional rejection is respectfully requested based on the filing herewith of an appropriate Terminal Disclaimer (with appropriate fees) for obviating the provisional obviousness-type double patenting rejection.

Claim Objections

Claims 17-20 have been objected to under the provisions of 37 CFR § 1.75 as being a substantial duplication of claims 13-16. While not agreeing with or acquiescing to the grounds of objection, withdraw of the objection is nonetheless required based on the cancellation of claims 13-16 herein.

Claim Rejections – 35 USC § 102

Claims 13-30 have been rejected under the provisions of 35 USC § 102(e) as being anticipated by **Ogane US ‘124** (US 2002/0143124). Claims 13-30 have also been rejected under the provisions of 35 USC § 102(a) as being anticipated by **Ogane DE ‘188** (DE 101 64 188). Reconsideration and withdraw of each of these rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Earlier filed 37 CFR §1.132 Declaration

With applicant’s prior response of June 13, 2005, there was enclosed a 37 CFR § 1.132 Declaration of Mr. Kazuo TAKAOKI, the instant inventor. The Examiner is respectfully requested

to again review Mr. TAKAOKI's declaration at this time, as it is submitted to be material to a consideration of the patentability of instantly pending claims 17-30.

For completeness, it is noted that the *MPEP* at § 2144.08 clearly sets forth that rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), by counsel, *In re Chu*, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), or by way of an affidavit or declaration under 37 CFR 1.132, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687; *In re Piasecki*, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984). That USPTO office personnel should consider all rebuttal arguments and evidence presented by applicants. A determination under 35 USC § 103 should rest on all the evidence and should not be influenced by any earlier conclusion. See, e.g., *Piasecki*, 745 F.2d at 1472-73, 223 USPQ at 788; *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Thus, once the applicant has presented rebuttal evidence, USPTO office personnel should reconsider any initial obviousness determination in view of the entire record. Office personnel should not evaluate rebuttal evidence for its "knockdown" value against the *prima facie* case, *Piasecki*, 745 F.2d at 1473, 223 USPQ at 788, or summarily dismiss it as not compelling or insufficient. If the evidence is deemed insufficient to rebut the *prima facie* case of obviousness, USPTO office personnel should specifically set forth the facts and reasoning that justify this conclusion.

Distinctions Over Ogane US '124

The present fundamental process claim (claim 17) is directed to a process consisting essentially of the step of contacting:

- (i) a compound represented by the formula $\text{BiL}^{\text{I}}_{\text{m}}$,
- (ii) a compound represented by the formula $\text{R}^{\text{I}}_{\text{1-n}}\text{TH}_n$, and

- (iii) a particle.

In contrast to the present invention, the cited prior art of Ogane US '124 discloses a process comprising the step of contacting:

- (i) a compound represented by the formula $M^1L^1_m$,
- (ii) a compound represented by the formula $R^1_{i-1}TH$,
- (iii) a compound represented by the formula $R^2_{i-2}TH_2$, and
- (iv) a particle.

As such, the cited Ogane US '124 reference is incapable of anticipating the present invention as claimed, since it fails to teach or provide for each of the limitations as instantly recited in pending process claims 17-30. Moreover, Ogane US '124 utilizes therein a compound represented by the formula $R^2_{i-2}TH_2$, which is excluded from the instantly claimed invention by way of the limiting transitional phrase "consisting essentially of" which is now recited in pending claim 17.

More particularly, regarding the use of the transitional phrase "consisting essentially of" in the claims (e.g., see claim 17), the following statements set forth in MPEP § 2111.03 are specifically noted for the Examiner's review and consideration.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)... "A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d

1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. vs. Calco, Ltd.*, 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988).... If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989)....

In order to facilitate the Examiner's comparison of the present invention with the teachings and disclosure of the cited art of Ogane US '124, the following table A is provided.

TABLE A

Present Invention	Ogane US '124	Comparison
(i) BiL_m^1	(i) M^1L_m^1	Same as each other
(ii) $\text{R}_{1-n}^1\text{TH}_n$	(ii) $\text{R}_{1-1}^1\text{TH}$	Same as each other
(iii) particle	(iv) particle	Same as each other
-----	(iii) $\text{R}_{1-2}^2\text{TH}_2$	<u>See the following</u>

As shown in the above TABLE A, the cited Ogane US '124 reference always requires the presence of an $\text{R}_{1-2}^2\text{TH}_2$ component, which is not part of the present invention as claimed, and which is excluded from the recited process step in independent claim 17 of the present invention, by the use of the limiting transitional phrase "consisting essentially of".

More generally, regarding the use of $R^2_{t-2}TH_2$, as taught in Ogane US '124, the present specification as filed does not mention the same and the presently pending claims likewise exclude the same in their recited process steps (e.g., see claim 17), since it is not part of the present invention.

Indeed, if $R^2_{t-2}TH_2$ is included in the present invention, there cannot be obtained a catalyst having a high polymerization activity. This is clearly shown in the earlier submitted 37 CFR § 1.132 declaration of Mr. Takaoki, which was filed in the matter of the instant application on June 13, 2005.

More specifically, in Table 1 of Mr. Takaoki's 37 CFR § 1.132 Declaration (*see page 6 thereof*) it is shown as follows:

Example 2
(Inventive Example)

- Using no $R^2_{t-2}TH_2$ had a polymerization activity of 3,500;

Experiment 1
(Comparative Example)

- Using water (H_2O as $R^2_{t-2}TH_2$, $Bi/H_2O = 1/1$ by mole) had a polymerization activity of 2,634, which is smaller than that obtained in Example 2 (i.e., 3,500); and

Experiment 2
(Comparative Example)

- Using a smaller amount of water (H_2O as $R^2_{t-2}TH_2$, $Bi/H_2O = 1/0.25$ by mole) had a polymerization activity of 2,308, which is much smaller than that obtained in Example 2 (i.e., 3,500).

Accordingly, such facts of distinction, and such comparative test results show that the present invention as claimed is not anticipated or rendered obvious by the cited Ogane US '124 reference of record.

Distinctions Over Ogane DE '188

Since the cited Ogane DE '188 reference is a counter-part of the cited Ogane US '124 reference, it also follows that the instantly claimed invention is not anticipated by Ogane DE '188 for the reasons described above, and is further not rendered obvious thereby. For example, the cited Ogane DE '188

reference does not provide any motivation to those of ordinary skill in the art to exclude its $R_{12}^2TH_2$ component, such as water.

CONCLUSION

Based on the remarks submitted herein, and the comparative testing set forth in Mr. TAKAOKI's earlier filed 37 CFR § 1.132 Declaration, as well as the filing of the enclosed Terminal Disclaimer, the Examiner is respectfully requested to reconsider and withdraw each of the outstanding rejections of record, and to issue a Notice of Allowance, clearly indicating that each of pending claims 17-30 is allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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Enclosure: Terminal Disclaimer (over U.S. Application Serial No. 10/220,022).